REMARKS

Upon entry of this Response, claims 1-8 and 10-29 remain pending in the present patent application. No amendments are offered herein, where the listing of claims is provided for the sake of convenience. Applicant requests reconsideration in view of the following remarks.

In item 4 of the Office Action, claims 1, 6-9, 11, 16-18, and 23-25 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent 6,369,909 issued to Shima (hereafter "*Shima*"). Anticipation under §102 "requires the disclosure in a single prior art reference of each element of the claim under construction." W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303, 313 (Fed. Cir. 1983). For the reasons that follow, Applicants assert that the rejection of the above-mentioned claims under §102(e) is improper. Accordingly, Applicants request that the rejection of these claims be withdrawn.

To begin, claim 11 provides as follows:

> 11. A system for brokered rendering, comprising:
> a processor circuit having a processor and a memory;
> a rendering request stored in the memory, the rendering request including a document embodied in a non-rendered format, the rendering request being received from a remote device and requesting a conversion of the document embodied in the non-rendered format into a rendered format; and
> a rendering broker stored in the memory and executable by the processor, the rendering broker comprising:
> logic that examines the a document embodied in the non-rendered format to identify at least one rendering operation to be performed to convert the document into the rendered format to be employed in printing the document;
> logic that identifies at least one rendering application capable of performing the at least one rendering operation;
> logic that applies the document to the at least one rendering application to implement the at least one rendering operation; and
> logic that transmits the document embodied in the rendered format back to the remote device, the document embodied in the rendered format being received from the at least one rendering application.

With respect to claim 11 above, the Office Action states:

> "Regarding claim 11, Shima teaches in embodiment 7 (Figs. 22-26, cols. 31-34) **a system for brokered rendering** (Fig. 22), **comprising:**

A processor circuit having a processor and a memory (Fig. 23, the printer 81 includes an image controller 92, wherein it is inherent that a controller includes a processor and memory to perform the functions specified);

A rendering request (step 2310 of Fig. 24 teaches receiving requests from other remote printers when the remote printer can't render the document; col. 32 lines 8-11; col. 33 lines 19-32) **stored in the memory** (it is inherent that internal operations of the printer are stored in memory, including request and document), **the rendering request including a document embodied in a non-rendered format** (step 2310 of Fig. 24 indicates that unrendered data that can't be rendered at the remote printer are transmitted, thus the received data is unrendered), **the rendering request being received from a remote device** (from a remote printer, Fig 22 shows the printers being remote from each other; col. 32 lines 8-11) **and requesting a conversion of the document embodied in the non-rendered format** (the purpose of transfer is to have the second printer render the document; col. 32 lines 8-11 and col. 33 liens 19-32); **and**

a rendering broker stored in the memory and executable by the process, the rendering broker comprising (functional blocks 121, 123A, 123B, 125, included in image controller represent operations executable by the image controller):

logic that examines the document embodied in the non-rendered format to identify at least one rendering operation to be performed to convert the document into the rendered format to be employed in printing the document (the image controller receives a composite non-rendered document and identifies the file format of the resource to determine which operation should be performed to render the resource; col. 31 lines 54-67 and col. 32 lines 1 – 11 and 50 - 55);

logic that identifies at least one rendering application capable of performing the at least one rendering operation (col. 32 lines 1-2 teach sending the resource to a specific rendering application that performs the necessary 'corresponding' rendering operation to the file format);...." (Office Action, Pages 3-4)

Applicants respectfully disagree. In particular, claim 11 specifies that the rendering request is stored in a memory and includes a document embodied in non-rendered format, the rendering request having been received from a remote device and requesting the conversion of the document embodied in the non-rendered format into a rendered format. In addition, claim 11 further comprises that the rendering broker is stored in the memory and is executable by the processor of the processor circuit. This memory is the memory within which the rendering request is stored.

In this respect, the rendering broker is the same device that receives the rendering request with the document embodied in the non-rendered format. The rendering broker then examines the document embodied in the non-rendered format to identify the at least one rendering operation to be performed to convert the document into the rendering format, and the rendering broker identifies the rendering application capable of performing the desired rendering operation.

Thus, it is a single device that performs all of these functions as opposed to the devices described by *Shima*. Specifically, the "second printer" that performs the rendering of a file in "file format C" does not make a determination as to the non-rendered format of a document, and does not identify the operation to be performed to convert the document into the rendered format. Likewise, the second printer does not identify the rendered application capable of performing the rendering operation as set forth in claim 11. Rather, such determinations are made by the first printer that sends the document with the request for rendering, where the first printer knows that the second printer is capable of rendering the file format C as described.

The configuration as set forth in claim 11 thus differs from the description of the printers of *Shima*. This difference is significant in that the rendering broker system described by claim 11 does not know anything about the device that sends the rendering request thereto. Rather, the rendering broker system described in claim 11 receives a rendering request and includes all of the functionality in one location in order to make the determination of what kind of rendering must be performed and to perform such rendering and then to send the document back to the requesting device. Thus, the creation of the rendering broker system requires much more programming time and effort as such system is much more complex than the device as described by *Shima*. Specifically, in Shima, the rendering is performed so that a given document is rendered in a format that is compatible with the first printer.

This is because the rendering broker system described by claim 11 is configured to interface with many different devices beyond simple printers as described by *Shima*. For example, the remote device may comprise a computer system or personal digital assistant as described in the instant specification. Also, the rendering broker of claim 11 facilitates rendering document into many different formats compatible with a multitude of different types of printers.

It is this complexity and greater capability of the rendering broker system described in claim 11 that makes the differences between the devices described by

Shima significant to the extent that the devices described by *Shima* do not have the full capabilities of the rendering broker system described by claim 11 given the nature of its operation.

In addition, Applicants reiterate the fact that a rejection under §102 must show each of the elements of the present invention in a single document. Mindful of the significant burden to be met in generating a proper rejection under 102, Applicants assert that the rejection of claim 11 under 102 is inadequate as it fails to show or suggest each of the elements of claim 11.

Accordingly, Applicants request that the rejection of claim 11 be withdrawn. In addition, Applicants request that the rejections of claims 1, 18, and 25 be withdrawn for similar reasons as described above with reference to claim 11. In addition, Applicants request that the rejection of claim 6-8, 16-17, and 23-24 be withdrawn as depending from claims 1, 11, or 18.

In addition, in item 5 of the Office Action, 2-5, 10, 12-15, 19-22, and 26-29 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Shima*. A prima facie case of obviousness is established only when the prior art teaches or suggests all of the elements of the claims. MPEP §2143.03, In re Rijckaert, 9 F.3d 1531, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). Applicants assert that the rejection of these claims is improper as depending from claims 1, 11, 18, or 25, for the reasons described above. In addition, Applicants assert that *Shima* teaches away from the invention as described in claims 1, 11, 18, and 25. In particular, the printers of *Shima* are all located within a single local area network and know of each other given that they includes tables that describe each other's capabilities as set forth with respect to FIG. 25. In contrast, the rendering broker service according to the present invention may not actually know the device from which it receives a rendering request and is configured for operation on a greater network such as the Internet to interface with multiple different client print devices as described. Thus, *Shima* teaches away from the rendering broker as described in the present claims.

Accordingly, Applicants request that the rejection of claims 2-5, 10, 12-15, 19-22, and 26-29 be withdrawn as depending from claims 1, 11, 18, and 25.

CONCLUSION

Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding this Response, the Examiner is encouraged to telephone the undersigned counsel of Applicants.

Respectfully submitted,

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